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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/399,288	09/17/1999	JARI JUOPPERI	297-008889-U	2110

7590

10/18/2005

CLARENCE A GREEN  
PERMAN & GREEN  
425 POST ROAD  
FAIRFELD, CT 06430

EXAMINER
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ZIA, SYED

ART UNIT	PAPER NUMBER
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2131

DATE MAILED: 10/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/399,288	JUOPPERI ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Syed Zia	2131	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 11 July 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 3-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 6, 7, and 9-15 is/are allowed.
- 6) ☒ Claim(s) 3-5 and 8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input checked="" type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

*pd*

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on July 11, 2005 has been entered.

### ***Response to Amendment***

This office action is in response to amendment filed on July 11, 2005. Original application contained Claims 1-15. Applicant previously cancelled Claims 1-2. Applicant previously amended claims 3-15. Applicant currently amended Claims 3, 6, and 8. Applicant amendments filed on July 11, 2005 have been entered and made of record. Therefore, presently pending claims are 3-15.

### ***Allowable Subject Matter***

6. Claims 6, 7 and 9-15 are allowable over the prior art of record.

### ***Response to Arguments***

3. Applicant's arguments filed July 11, 2005 have been fully considered but they are not persuasive because of the following reasons:

Regarding Claims 3-5 applicants argued that in the cited prior art (CPA) [Chang et al. (0-7803

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3692, IEEE 5/96)] (hereinafter 'Chang'), does not disclose or suggest "the possibility of making mobile station exchange authentication data during a call in a situation where there is a need for exceptionally secure communications (i.e. extra secure transmission" extra secure communication", "extra secure call" extra secure connection" and extra secure feature")

This is not found persuasive. The system of Chang et al. clearly teaches and describes a system and method of end-to-end authentication protocol for devices communicating with each other in mobile network. Whenever a mobile device makes a call when mobile device roams into voice service domain, the authentication process is initiated and *challenge* of caller is forwarded to *called party* (end user) after VSD authentication. This end-to-end continuing authentication is explicitly described in Table 5 and 6 of prior art disclosure (page 1254 2<sup>nd</sup> column, and page 1255 2<sup>nd</sup> column last paragraph). Therefore, the system of cited prior art describes and provides system and method to authenticate mobile devices by user-to-user data exchange secure in a mobile network.

Applicants clearly still have failed to explicitly identify specific claim limitations, which would define a patentable distinction over prior arts. The examiner is not trying to interpret the invention but is merely trying to interpret the claim language in its broadest and reasonable meaning. The examiner will not interpret to read narrowly the claim language to read exactly from the specification, but will interpret the claim language in the broadest reasonable interpretation in view of the specification. Therefore, the examiner asserts that the system of cited prior arts does teach or suggest the subject matter broadly recited in independent Claim 3 and in subsequent dependent Claims. Accordingly, rejections for claims 3-5, and 8 are respectfully maintained.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 3-5, and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Chang et al. (0-7803-3692, IEEE 5/96, hereinafter 'Chang').

As per claim 3, Chan teaches the claimed method to authenticate a mobile station in a mobile network comprising: authenticating the mobile station with user-to-user data exchange; and exchanging the authentication data during a call when a need occurs for an extra secure communication during a call (page 1254, column 2, last paragraph).

As per claims 4 and 5, Chang also teaches that an encryption key is agreed between the mobile stations and that the mobile stations execute a mutual authentication and key agreement protocol based on public-key cryptography (page 1252, Section 1).

As per claim 8, Chan teaches the claimed method to authenticate a mobile station in a mobile network comprising: authenticating the mobile station with user-to-user data exchange; and exchanging the authentication data during call set-up or during a call wherein the authentication data is exchanged through user-to-user signaling (Fig.2, and page 1254, column 2, last paragraph).

*Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Syed Zia whose telephone number is 571-272-3798. The examiner can normally be reached on 9:00 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on 571-272-3795. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SZ

October 18, 2005

